UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,920	08/24/2001	J. Michael Milliorn	P02167US0	3498

26271 7590 02/22/2005

FULBRIGHT & JAWORSKI, LLP
1301 MCKINNEY
SUITE 5100
HOUSTON, TX 77010-3095

EXAMINER	
AHMAD, NASSER	

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/938,920	MILLIORN ET AL.	
	Examiner	Art Unit	
	Nasser Ahmad	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 November 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22-60* is/are pending in the application.

4a) Of the above claim(s) *39* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22-38 and 40-60* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/12/04, 7/30/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Rejections Withdrawn

1. Claims 22-28 and 32-38 rejected under 35 USC 102(b) as being anticipated by Voy in view of the amendment filed on November 29, 2004.

2. claims 22-38 rejected under 35 USC 1039a) as bein unpatentable over Voy in view of the amendment.

Response to Arguments

3. Applicant's arguments with respect to claims 22-38 and newly submitted claims 40-60 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 22-23, 25-28, 33-38, 47-48, 50-55 and 57-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Mace (6471815).

Mace relates to an adhesive label (see figure-5) comprising a rectangular shaped portion (16a) having a first surface printed with text/indicia, a back surface with adhesive

located thereon, a tab portion (16b) that extends from the rectangular shaped portion and having a back surface that is free of adhesive, and the adhesive is covered by the release web (18). The tab is configured for gripping and the adhesive is removable because the label is temporary attached to a substrate. The print ink will provide for the colored indicia.

It is understood by the examiner, in the absence of any express teaching otherwise, that the adhesive extends to at least a portion of an edge of the label as shown in the drawings.

The process of making the product is not germane to the issue of patentability of the product itself and therefore, this limitation has not been given patentable weight.

The intended use phrases such as "used in food", etc. have not been given patentable weight as said phrases are not deemed to be of positive limitations.

6. Claims 22-23, 25-31, 33-38, 47-48, 50-55 and 57-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Scott (6420006).

Scott relates to an adhesive label comprising a rectangular shaped portion (16) having a front surface (18) with text or graphic (22) thereon, a back surface (20) having a removable adhesive layer (28) thereon and extending to at least a portion of the edge of the label as shown in the drawings, a tab portion (24) with adhesive-free back surface, and the adhesive is covered by a release liner (38).

The process of making the product is not germane to the issue of patentability of the product itself and therefore, this limitation has not been given patentable weight.

The intended use phrases such as "used in food", etc. have not been given any patentable weight because said phrases are not found to be of positive limitations.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 22-38 and 40-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mace or Scott.

Both Mace or Scott, as discussed above, fails to teach that the label is circular shaped.

It would have been obvious to one having ordinary skill in the art to modify Mace or Scott by providing the label to have a circular shape for providing aesthetic appeal, since such a change would have involved a mere change in the shape of the product. A change in shape is generally recognized to be within the level of ordinary skill in the art. *In re Dailey*, 149 USPQ 47 (CCPA 1976).

With respect to the face material in claims 32, 42, 49 and 56, it is well known and conventional in the label art to use material such a paper, polyester, etc. as label face material for its printability as evidenced by Hamby (US Patent 6135507).

For claims 29-31, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Mace or Scott with more than one or a plurality of labels in a row based on mere duplication pf parts. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 22-38 and 40-60 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of copending Application No. 09/912,755. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant claimed invention and the copending application'755 are directed a label having rectangular or circular shaped portion with text on its front surface and adhesive on its back surface, and a tab portion that is adhesive-free on its back surface.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nasser Ahmad
Primary Examiner
Art Unit 1772

N. Ahmad.
February 17, 2005.